

## REMARKS

Claims 11-13, 16, 20-27, 32-34, 36, 44 and 50-99 are pending and under examination. Claims 70 and 82 have been cancelled.

Applicant appreciates Examiner Sang's time and helpful discussion with Applicant's representatives in the telephone interview on October 25, 2007.

Rejection Under 35 U.S.C. § 102

The rejection of claims 11, 13, 16, 20-22, 24-27, 32, 34, 36, 44, 50-61, 67, 68, 70-73, 75-79, 81-86, 88, 89, 91, 92, 94, 95, 97 and 98 under 35 U.S.C. § 102(b) as allegedly anticipated by Turner et al., Breast Cancer Res. Treatment 46:69 (1997), is respectfully traversed. Applicant respectfully maintains, for the reasons of record, that the claimed methods are novel over Turner et al.

Applicant respectfully asserts that the claims are directed to methods that include determining the level of BAG-1 expression in stage I of breast cancer. According to MPEP § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Turner et al. does not teach or suggest BAG-1 expression in stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

The rejection of claims 11-13, 16, 20-22, 24-27, 32-34, 36, 44, 50-61, 67-73, 75-86, 88, 89, 91, 92, 94, 95, 97 and 98 under 35 U.S.C. § 103 as allegedly obvious over Turner et al., *supra*, in view of Sano et al., U.S. Patent No. 5,665,539, is respectfully traversed. Applicant respectfully maintains, for the reasons of record and further as set forth below, that the claims are unobvious over the cited references whether viewed individually or in combination.

As discussed above and in the previous response, Turner et al. neither teaches nor suggests the claimed methods relating to stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Sano et al. does not cure this defect either, as it contains no

teaching or suggestions that would complement the teaching of Turner et al. with regard to stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Therefore, Applicant respectfully maintains that the claimed methods are unobvious over Turner et al., alone or in combination with Sano et al. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

The rejection of claims 11, 13, 16, 20-22, 24-27, 32, 34, 36, 44, 50-66, 67, 68, 70-73, 75-79 and 81-99 under 35 U.S.C. § 103 as allegedly obvious over Turner et al., *supra*, in view of Sauter et al., Br. J. Cancer 76:494-501 (1997), is respectfully traversed. Applicant respectfully maintains, for the reasons of record and further as set forth below, that Turner et al., alone or in combination with Sauter et al., does not teach or suggest the claimed methods.

As discussed above and in the previous response, Applicant respectfully maintains that Turner et al. does not teach or suggest the claimed methods relating to stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Furthermore, Applicant respectfully maintains that Sauter et al. does not cure the deficiencies of Turner et al. in teaching stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Therefore, Applicant respectfully maintains that the claimed methods are unobvious over Turner et al., alone or in combination with Sauter et al. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

The rejection of claims 11, 13, 16, 20-27, 32, 34, 36, 44, 50-61, 67, 68, 70-79, 81-86, 89, 91, 92, 94, 95, 97 and 98 under 35 U.S.C. § 103 as allegedly obvious over Turner et al., *supra*, in view of Takayama et al., Cancer Res. 58:3116-3131 (1998), is respectfully traversed. Applicant respectfully maintains, for the reasons of record and further as set forth below, that Turner et al., alone or in combination with Takayama et al., does not teach or suggest the claimed methods.

As discussed above and in the previous response, Applicant respectfully maintains that Turner et al. does not teach or suggest the claimed methods relating to stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Furthermore, Applicant respectfully maintains that Takayama et al. does not cure the deficiencies of Turner et al. in teaching stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Therefore, Applicant respectfully maintains that the claimed methods are unobvious over Turner et al.,

alone or in combination with Takayama et al. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

The rejection of claims 11, 13, 16, 20-22, 24-27, 32, 34, 36, 44, 50-66, 67, 68, 70-73, 75-79 and 81-99 under 35 U.S.C. § 103 as allegedly obvious over Turner et al., *supra*, in view of Love, U.S. Patent No. 6,221,622, is respectfully traversed. Applicant respectfully maintains that Turner et al., alone or in combination with Love, does not teach or suggest the claimed methods.

As discussed above and in the previous response, Applicant respectfully maintains that Turner et al. does not teach or suggest the claimed methods relating to stage I of breast cancer or stage II of breast cancer with no lymph node involvement. Furthermore, Applicant respectfully avers that Love does not cure the deficiencies of Turner et al. in teaching BAG-1 expression in stage I of breast cancer or stage II of breast cancer with no lymph node involvement. All Love does is to teach a method of obtaining fluids, marker substances and cellular material from single milk ducts in the breast of a patient for cancer diagnosis. Therefore, Applicant respectfully maintains that the claimed methods are unobvious over Turner et al., alone or in combination with Love. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

#### Objections to the Claims

The objection to claims 70 and 82 for alleged informalities is respectfully traversed. Applicant respectfully submits that the objection to claims 70 and 82 has been rendered moot by the cancellation of these claims. Accordingly, Applicant respectfully requests that the objection to claims 70 and 82 be withdrawn.

In light of the amendments and remarks herein, Applicant submits that the claims are now in condition for allowance and respectfully requests a notice to this effect. The Examiner is invited to call the undersigned agent if there are any questions.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Deborah L. Cadena". The signature is fluid and cursive, with the first name being the most prominent.

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